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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: Jim B. Estipona	§	Art Unit:	2614
Serial No.: 09/652,695	§	Examiner:	Nathan A. Sloan
Filed: August 31, 2000	§		
For: Announcing the Availability of an Electronic Programming Guide to Receivers of Enhanced Television Transmissions	§	Atty Docket:	ITL.0448US P9559

Mail Stop **Appeal Brief-Patents**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

In response to the new points raised by the Examiner in his Answer, the Applicant files the following Reply Brief.

In the Examiner's Answer, the new Examiner concedes that the so-called primary reference does not teach the availability of an electronic program guide as claimed. Of course, it is surprising that the new Examiner talks about a primary reference when there was no secondary reference before. Apparently, appreciating that a secondary reference is needed, the new Examiner attempts to insert a secondary reference but does so improperly and ineffectively. First, the new Examiner offers to provide a citation in support of the previous Examiner's finding of well known art. But the applicant never traversed the finding of well known art and, thus, the attempt to insert a new reference into the record is improper and should not be permitted. The original Examiner took official notice that "it is notoriously well known in the art of television

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broadcasting to broadcast an EPG for the purpose of efficiently navigating through available programming and data services." Thus, there is no need at this time to review the Kondo reference. Were the applicant to now review the Kondo reference on appeal, the process would never end. Compact prosecution requires that if the Examiner wanted to rely on an additional reference, he should have presented it during prosecution.

Secondly, the new Examiner attempts to assert that Gagnon reference which was never relied on before. The new Examiner suggests that the prior art now of record clearly shows that a multitude of items may be utilized to enhance television content. Again, the applicant could simply address this reference, but to do so simply makes prosecution never ending. It would bring into the record things that are not even properly raised. There is no showing of any rationale to combine the references. There is no showing of exactly how the Gagnon reference could be combined with some other reference. In fact, there is no showing of exactly how the Gagnon reference relates to the claim. For the Examiner now to attempt to open up prosecution during appeal is impermissible.

There is no authority whatsoever for the Examiner to cite such a reference. One can only hope that in keeping with the rules that the Patent Office must live by, if somehow in the unlikely event the Gagnon reference actually was pertinent, that the Examiner would have withdrawn the final rejection and started prosecution anew. Failing that, the applicant is well within his rights to resist the temptation to further distinguish these late offered references.

More disturbing is the fact that the previous Examiner cited, but did not apply, the Gagnon reference. If he felt it was somehow pertinent, he should have applied it before now.

A problem with the rejection based on the ATVEF specification is that the ATVEF specification provides innumerable tools to do innumerable things. What is claimed here is very specific. It is the application of the session identifier tool to announce the availability of an electronic programming guide.

Despite statements to the contrary by the new Examiner, electronic programming guides are not programming. This is clear from their very name. Programming is a television program like "All in the Family." An electronic programming guide is an electronic chart that indicates which programming is available at which times. Thus, electronic programming guides are enhancements that are normally handled separately from programming.

The assertion by the Examiner that "currently available programming" is notoriously well known to be presented in the form of an electronic programming guide (EPG) is untrue. Programming are television programs and anything other than a television program, under the specification, must be an enhancement or an announcement.

The patentability of the invention comes down to the basic question of whether or not announcing the availability of an electronic programming guide using a very specific tool known as a session identifier is patentable. To make this analysis, we must first determine whether or not a *prima facie* rejection has been made out. It is respectfully submitted that the single reference rejection as a matter of law cannot make out a *prima facie* rejection. There is nothing whatsoever within the ATVEF specification that ever contemplated using session identifiers for the claimed purpose. Thus, absent some principle of obviousness per se, there cannot be a rationale within the reference to modify itself to do something that it never contemplated.

The applicant has proposed an advantageous system that will enable everyone compliant with the ATVEF specification to provide a uniform way of specifying the availability of electronic programming guides. With such an easily implemented, and uniformly implementable system, uniformity could be achieved, resulting in better performance of advanced television programming system.

The argument that the official notice fills the gap that is missing in making out a *prima facie* rejection is incorrect. The taking of official notice that it is well known to broadcast electronic programming guides does not meet the scope of the claimed invention. The cited reference to the ATVEF specification says you can broadcast programming with enhancements. The stated well known art says, according to the Examiner, that you can also broadcast electronic programming guides. But still missing is the concept of announcing the availability of the electronic programming guide with the specific tool called a session identifier. Plainly, the official notice fails to provide that supplementation which would be necessary to augment the so-called primary reference to meet the claimed invention.

Thus, the primary reference and the official notice fail to rise to the level of detail claimed in the present claim. There is no rationale provided or other teaching which would modify the reference to teach the use of a session identifier to announce the availability.

The Examiner suggests that a session identifier could be utilized to announce the availability of anything and, therefore, it is obvious to use a session identifier to announce the

availability of an electronic programming guide. But, of course, this is not the case. The session identifier was never intended to announce any specific type of information. It was to announce a session as defined in the SDP spec. See ATVEF specification at page 13 at the top. It is explained there that session ID identifies an announcement for a particular broadcast (it can be a permanent announcement for all programming on a broadcast channel or for a particular show). It was never intended to announce a specific type of enhancement. In other words, the concept of using the session identifier to uniquely describe a particular type or class of enhancement was never contemplated within the standard. Here, what is done is to use a relatively innocuous tool to announce a particular type of enhancement. By using, for example, a uniform session identifier, everyone knows that what is being announced is an electronic programming guide in particular. This concept is nowhere present within the ATVEF specification.

The assertion that Gagnon teaches that a multitude of items may be utilized to enhance the television content is certainly too little, too late. It would be improper to raise this at this point. But even assuming such an argument were true, it still does not meet the claimed invention and Gagnon literally teaches away. If a multitude of items may be utilized to enhance television content, why does that make particular modality claimed obvious, despite the multitude of other ways used in the past?

The argument that the use of this particular claimed technique is either simple or obvious begs the proper obviousness analysis. The Examiner mistakenly equates simplicity with non-patentability when, in fact, simplicity and difference from the art strongly indicates patentability. If it was simple, someone would have done it before if it was so obvious.

The conclusory observation that it is obvious, is also an improper statutory requirement. What the Examiner means is, with the benefit of hindsight, it is obvious. That, of course, is not the test. The test is whether the Examiner has garnered that evidence which objectively demonstrates non-obviousness.

Finally, the argument that the applicant is trying to gain patent protection on something that the ATVEF specification anticipates is equally incorrect. There is nothing in the ATVEF specification that teaches the claimed invention. If there were, we would not be on appeal right now.

Similarly, the argument that the case is not allowable "merely because the announced available programming is not referred to as an EPG is not found convincing" is a red herring

argument. Of course, this is not the basis for patentability. The claim does not call for announcing the availability of an electronic programming guide. It calls for using a session identifier to do so.

The argument that the reference discloses the use of session identifiers that include unique session identifiers "which by definition must be numeric strings" having values that announce the availability of particular broadcasts is simply untrue. There is no such thing anywhere in the specification. The citation to material that says a session identifier may permanently announce all programming on a broadcast channel for a particular show does not indicate anything about the concept of using a session identifier to indicate a particular type of enhancement. In other words, one implementation of the present invention is that a unique session identifier number be utilized that would be recognized by everyone as indicating that the enhancement is an electronic programming guide. This type indication is nowhere suggested anywhere in the specification and has never been pointed out by the Examiner.

Finally, the Examiner attempts to argue that because the applicant's specification indicates that his system would be ATVEF compliant that, therefore, it cannot be patentable. Of course, this argument is frivolous. Hopefully, thousands of inventions will be made and patents will be granted for systems which are totally compliant with the ATVEF specification. The fact that systems may be compliant with the rules of the ATVEF specification and still have patentable differences thereover is so fundamental to patent law that it is unfortunate that it must be raised at this stage in prosecution.

Since a *prima facie* rejection is not made out, the rejection of the claims should be reversed.

Respectfully submitted,

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